

REMARKS

In response to the office action of May 12, 2005, please amend the above-identified application. Please amend claims 1, 2, 12 and 20.

Claim 20 was objected to because of informalities. Claim 20 has been amended.

Claims 1-8 and 12-18 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,582,458 to Korb et al.

Applicant believes that Claims 1-8 and 12-18 are allowable for the following reasons. The newly cited prior art does not disclose elements of the inventive multiple-stage drill as set forth in claim 1. US 4,582,458 does not anticipate the inventive multiple-stage drilling tool as there is no core bit. Therefore drilling in solid material is not possible and a guiding drill is necessary to enable drilling in solid material. During drilling with the first stage it will leave no core material which could be used further (this is an important feature when precious metal has to be drilled). In fact, the '458 patent does not include the word "core."

Anticipation requires that all elements and limitations of the claim are found within a single prior art reference. Anticipation must be exact; there must be no difference between the claimed invention and the reference disclosure. *Carella v. Starlight Archery and ProLine Co.*, 804 F.2d 135, 138, 231 USPQ 644, 646 (Fed. Cir. 1986). *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1549, 220 USPQ 193, 198 (Fed.

Cir. 1983). *Kalman v. Kimberly-Clark Corp.*, 218 USPQ 781 (Fed. Cir. 1983). The reference does not teach or disclose the use of a core bit leaving a cylinder shaped core of uncut material behind, two essential features of the instant invention as claimed in claim 1. As a result this reference does not anticipate the instant invention as recited in claim 1 or in any other of the claims 2-8 or 12-18 which depend from claim 1 directly or indirectly. Reconsideration of claims 1-8 and 12-18 is respectfully requested.

Claims 1-8 and 12-18 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,466,100 to Ahluwalia.

With respect to US 5,466,100, applicant believes that the following key differences and the absence of certain features prevent the reference from anticipating the instant invention. The first stage of the drill is configured as a twist drill and does not have a core bit. In fact, the '100 patent to Ahluwalia does not include the word "core."

Most importantly, the reference again does not teach the use of a core bit or leaving an uncut cylinder-shaped of core material behind. These are two essential features of the instant invention as claimed in claim 1. As a result this reference does not anticipate the instant invention in claim 1 or in any of the other claims 2-8 or 12-18 which depend directly or indirectly from claim 1. Reconsideration of claims 2-8 and 12-18 is respectfully requested.

Claims 1-8 and 12-18 were rejected under 35 U.S.C. 102(b) as being anticipated by JP 63016912 A to Shibata.

JP 63016912 to Shibata discloses the use of a fine bore drill used in conjunction with cutting edges to open a large hole. There is no disclosure of using a core bit to leave an uncut cylinder-shaped core of material behind. This reference does not contain all of the elements necessary for anticipation to occur. Applicant believes that claim 1 is allowable and as a result all of the remaining claims which depend directly or indirectly from claim 1 are allowable.

Claims 9-11, 19, 20, and 22-26 were objected to as being dependent upon a rejected base claim.

Claims 1, 2, 12 and 20 have been amended for clarification but have not been amended substantively. Claim 1 is patentable over the recited references. Claims 9-11, 19, 20 and 20-26 are directly or indirectly dependent on allowable claim 1 and as such are patentable.

Applicant notes that the Examiner has determined that allowable subject matter has been determined in claims 9-11, 19, 20, and 22-26 and wishes to thank the Examiner for that determination. Claims 9-11, 19, 20, and 22-26 are not being rewritten at this time as it is believed that claim 1 is allowable based on the applicant's belief that none of the references disclose the use of a core bit or leaving behind an uncut cylinder-shaped core as claimed in claim 1 of the instant invention.

Reconsideration of claims 1-20 and 22-26 is respectfully requested.

The undersigned invites a telephone call from the Examiner if it would expedite

the processing and examination of the application.

Respectfully submitted,

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